

Appl. No. 09/297,591
Atty. Docket No. JA171
Amdt. dated 09/27/2004
Reply to Office Action of 08/26/2003
Customer No. 27752

REMARKS

Claims 1-13 are pending in this application and all presently stand rejected. By the amendments presented herein, Applicant amended Claim 1 and Claim 4, whereupon Claims 1-13 remain to be examined. No fee is believed to be due as a result of these amendments. No new matter is being added.

Claim 1 has been amended to more distinctly claim amphoteric polymers of the present invention. Basis lies, as least, at page 3, line 17 through page 7, line 9, of the Application as originally filed.

Claim 4 has been amended to more distinctly claim particular embodiments of the invention by claiming amphoteric polymers that may be used in the invention. Basis lies, at least, at page 3, line 20 through page 4, line 34, of the Application as originally filed. By this amendment, the 35 U.S.C. 112, second paragraph rejection of Claims 5 and 6, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, has been addressed.

Therefore, reconsideration and withdrawal of the claim rejection under 35 U.S.C. 112, second paragraph is requested.

35 U.S.C. § 103

Under 35 U.S.C. §103(a), Claims 1-13 are rejected as being unpatentable over U.S. Pat. No. 4,240,450, issued to Grollier, et al. [hereinafter "Grollier"]. Further, under 35 U.S.C. §103(a), Claims 1-13 were further rejected as being unpatentable over U.S. Pat. No. 5,254,333, issued to Kajino et al. [hereinafter "Kajino"]. Applicant respectfully traverses these rejections as applied to Claims 1-13 in view of the arguments presented herein.

Grollier (U.S. 4,240,450)

To establish a *prima facie* case of obviousness, under 35 U.S.C. §103, three elements must be met: (a) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and (b) there must be a reasonable expectation of success; and (c) the prior art reference(s) must teach or suggest all the claim limitations. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Merck & Co., Inc.*, 231 USPQ 375 (Fed. Cir. 1986); *In re Royka*, 180 USPQ 580 (CCPA 1974). See also, MPEP 2142. Applicant submits that the references cited by Examiner fails to establish a *prima facie* case of obviousness.

Appl. No. 09/297,591
Atty. Docket No. JA171
Amdt. dated 09/27/2004
Reply to Office Action of 08/26/2003
Customer No. 27752

Grollier generally mentions amphoteric polymers as possible, optional ingredients. However, the only type of amphoteric polymer specifically disclosed in Grollier are certain crosslinked and alkylated amphoteric amidoamine polycondensates (col. 44, lines 42-52). However, as now amended, the present invention is directed to amphoteric polymers selected from polymers (1), (2), (3) and (5) as described in the specification on page 3, line 20 to page 5, line 25 and page 6 line 26 to page 7, line 9. Such specified amphoteric polymers are neither disclosed nor suggested in Grollier. Therefore, a prima facie case of obviousness cannot be based on Grollier in view that Grollier does not teach or suggest all the claim limitations.

Grollier teaches anchoring of anionic polymers on keratinic material by combining the anionic polymers with cationic polymers (col. 2, lines 7-10). Additionally, Grollier teaches that amphoteric polymers could be added as optional ingredients without disclosing or suggesting any benefits or amounts or amount ratios in respect to the amphoteric polymers. The expectation of a skilled person would be that the addition of an amphoteric polymer would not result in any special effect and would neither do any harm or provide any benefit to the combination of anionic and cationic polymers. Therefore, a prima facie case of obviousness cannot be based on Grollier in view that Grollier does not disclose any suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, which would lead to modify the reference or to combine reference teachings.

Furthermore, Grollier teaches that the hold of the hair can be improved by a proper selection of the cationic polymer and that the softness and suppleness of the hair (as the opposite of good hold) can be improved by a proper selection of the anionic polymer (col. 2, lines 50-63). Grollier does not disclose or suggest anything about film flexibility and how it could be improved to such an extent that re-arrangement of hair is possible. To one of skill in the art, there is no reasonable expectation of success that any one of the numerous optional ingredients mentioned by Grollier would (when added in specific amounts and amount ratios) result in the desired increase of film flexibility. Therefore, a prima facie case of obviousness cannot be based on Grollier in view that Grollier does not provide a reasonable expectation of success.

As Applicant has demonstrated that a prima facie case of obviousness has not been established, the Applicant notes that the Examiner has asserted in prior Office Actions, incorporated herein, that the test for obviousness is not that the claimed invention must be expressly suggested in references. Rather, the Examiner asserted, the test is what the combined teachings of the reference would have suggested to those of ordinary skill in the art. See *In re Keller*, 208 USPQ 871 (CCPA 1981). Applicant has demonstrated that to one of skill in the art Grollier does not disclose any suggestion or motivation, either in the reference or in the

Appl. No. 09/297,591
Atty. Docket No. JA171
Amdt. dated 09/27/2004
Reply to Office Action of 08/26/2003
Customer No. 27752

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, as demonstrated in the remarks above. Further, to one of skill in the art, Grollier does not provide a reasonable expectation of success, as demonstrated in the remarks above.

Kajino (U.S. 5,254,333)

The Examiner has stated that Kajino was discussed in the prior Office Action of 1/11/01 and the same are incorporated in the present Office Action. The Examiner asserted that the difference between Kajino and the claimed invention is that the reference does not disclose the combination of the three types of polymers in the specified amounts. To establish prima facie obviousness of the claimed invention, all of the claim limitations must be taught or suggested by the prior art. Kajino does not teach or suggest compositions as now defined and amended in the present invention.

The desired success of the present invention includes providing a hair styling composition which provides flexible and good holding film texture which allows re-arrangement of hair (page 1, lines 26-29 and page 2, lines 15-20). Kajino does not disclose any hair styling composition or any composition that could be expected to allow for holding hair or even holding the hair style after a re-arrangement. The object of the invention described by Kajino is to provide conditioning effects to hair (col. 2) such as making hair highly smooth and very soft (as demonstrated in the examples). Highly smooth and very soft hair is generally expected by one of skill in the art to be too weak to give any hold or styling effect. Thus, for one of skill in the art, there would be no expectation of success that a modification of the Kajino compositions would change them from purely conditioning compositions without hold properties into hair styling compositions. Therefore, a prima facie case of obviousness cannot be based on Kajino in view that Kajino does not provide a reasonable expectation of success.

Furthermore, Kajino has no disclosure for polymer films, their textures, flexibility or holding properties. On the contrary, Kajino teaches that when hair is treated by its compositions, the polymers of component (B) penetrate into the hair so as to exert conditioning effects (col 2, lines 26-30). To one of skill in the art, penetration of the polymers into the hair contradicts the formation of a film which necessarily must be on the outer surface of the hair. Something that penetrates into the hair cannot form a film on the outside and something that forms a film on the outside does not penetrate into the inside. Since Kajino does not disclose any polymeric film texture there can be no hint or suggestion how to improve or optimize a film texture to make it flexible enough to provide for re-arrangement of the hair, to one of skill in the art. There can be

Page 9 of 10

Appl. No. 09/297,591
Atty. Docket No. JA171
Amdt. dated 09/27/2004
Reply to Office Action of 08/26/2003
Customer No. 27752

no expectation of success for one of skill in the art that a specific selection of three polymer types together with a selection of their amounts and ratios would lead to a polymer film having the desired flexibility to allow for re-arrangement of hair, from the teaching of Kajino.

To one of skill in the art, the teaching of compositions penetrating into the hair, as taught by Kajino, teaches away from compositions forming films on the outer surface of hair and the teaching of compositions making hair smooth and soft teaches away from compositions giving good hold to hair.

As Applicant has demonstrated that a prima facie case of obviousness has not been established, the Applicant notes that the Examiner has asserted in prior Office Actions, incorporated herein, that the test for obviousness is not that the claimed invention must be expressly suggested in references. Rather, the Examiner asserted, the test is what the combined teachings of the reference would have suggested to those of ordinary skill in the art. See *In re Keller*, 208 USPQ 871 (CCPA 1981). Applicant has demonstrated that to one of skill in the art Kajino does not provide a reasonable expectation of success, as demonstrated in the remarks above. Further, to one of skill in the art, Kajino actually teaches away from the present invention, as demonstrated in the remarks above.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103. Early and favorable action in the case is respectfully requested.

Applicant has made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicant respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1 to 13.

Respectfully submitted,

Takanori Nambu

By Linda M. Sivik

Linda M. Sivik
Agent for Applicant(s)
Registration No. 44,982
(513) 626-4122

September 27, 2004
Customer No. 27752